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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,386	04/03/2002	Sharron Gaynor Penn	PB-01106	4235

22840 7590 01/29/2004

AMERSHAM BIOSCIENCES  
PATENT DEPARTMENT  
800 CENTENNIAL AVENUE  
PISCATAWAY, NJ 08855

EXAMINER
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MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/029,386

Applicant(s)

PENN ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Reconsideration of the instant application has revealed that numerous patentably distinct inventions are included in various claims which were not previously made subject to a restriction/election requirement. This Office action therefore vacates the previous restriction/election requirement, mailed 8/15/03, and replaces it with the following new set of restriction/election requirements. The election, filed 10/17/03, by applicants is acknowledged. Due to the below set forth newly applied restriction/election requirements, applicants are hereby required to re-elect an appropriate invention for examination.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-40 and 44, drawn to nucleic acid probes for measuring human gene expression selected from SEQ ID Nos: 13,701-27,400 and Tables 4-11 and vectors, classified in class 536, subclass 23.1, and class 435, subclass 320.1. If this Group is elected then the below summarized sequence election is also required.
- II. Claims 41-43, drawn to a method of measuring human gene expression using a microarray, classified in class 435, subclass 6. If this Group is elected then the below summarized sequence election is also required.
- III. Claims 45-46, drawn to an ORF-encoded peptide, classified in class 530, subclass 300 or 350, for example. If this Group is elected then the below summarized sequence election is also required.

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- IV. Claim 47, drawn to an antibody, classified in class 424, subclass 130.1. If this Group is elected then the below summarized sequence election is also required.
- V. Claims 48 and 49, drawn to a method of selling and/or licensing, classified in class 705, subclass 26. If this Group is elected then the below summarized sequence election is also required.
- VI. Claim 50, drawn to a method of providing human gene expression data by subscription by making a database available, classified in class 707, subclass 3. If this Group is elected then the below summarized sequence election is also required.
- VII. Claim 51 and 53, drawn to a computer readable storage medium, classified in class 707, subclass 100. If this Group is elected then the below summarized sequence election is also required.
- VIII. Claim 52, drawn to a computer system, classified in class 700, subclass 1. If this Group is elected then the below summarized sequence election is also required.

**Sequence Election Requirement Applicable to All Groups:**

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence, or, a specific set thereof. For an elected Group drawn to nucleotide sequences, the Applicants must elect a single nucleic acid sequence, or, a specific set thereof (See

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MPEP 803.04). It is noted that the multitude of sequence submissions for examination has resulted in an undue search burden if more than one nucleic acid sequence is elected, thus making the previous waiver for up to 10 elected nucleic acid sequences effectively impossible to reasonably implement. It is acknowledged that the instant claims are inclusive of embodiments of invention directed to one, a plurality, a set, or even large sets of sequences (See, for example, instant claims 29 and 31.). In recognition of these embodiments, applicants may elect, one of the alternatives of, one specific sequence or a specific set of sequences defined by SEQ ID NOs.; for example.

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Examination will be restricted to only the elected sequence, or set of sequences. It is additionally noted that this sequence election requirement is a restriction requirement and not a specie election requirement.

#### **RESTRICTION GROUP DISTINCTIONS**

The basis for distinctnesses between Groups I – VIII is reiterated and maintained from the previous written restriction Office Action, mailed 8/15/03.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571)272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571)272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571)272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

January 22, 2004

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER